

REMARKS

Claims 1-20 were pending in this application.

Claims 6-10 have been allowed.

Claims 1-5 and 11-16 have been rejected.

Claims 17-20 have been objected to.

No claims have been amended.

Claims 1-20 remain pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 6-10 are in condition for allowance. These claims have not been amended and therefore remain in condition for allowance.

The Applicants also thank the Examiner for the indication that Claims 17-20 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicants believe that the remaining claims in this application are allowable, the Applicants have not rewritten Claims 17-20 in independent form.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-4 and 11-13 under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent No. 6,233,637 to Smyers et al. ("Smyers") in view of U.S. Patent No. 6,415,345 to Wu et al. ("Wu"). The Office Action rejects Claims 5 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Smyers* and *Wu* in further view of Applicant Admitted Prior Art ("APA"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

Regarding Claim 1, the Office Action acknowledges that *Smyers* fails to recite a "plurality of register transfer unit[s]" that "facilitate transfers of data" among "interface registers" as recited in Claim 1. (*Office Action, Page 2, Last paragraph*). The Office Action then asserts that *Wu* recites these elements of Claim 1 and that it would be obvious to modify *Smyers* with *Wu*. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*).

Wu recites a bus interface control system that allows a bus master interface to request data from a host memory without interrupting a host processor. (*Abstract*). The system includes a bus master FIFO controller. (*Col. 9, Lines 1-2*). The bus master FIFO controller includes two "register interfaces" for two DSPs. (*Col. 9, Lines 17-19*). Each register interface includes multiple registers. (*Col. 9, Lines 19-23*).

First, *Wu* simply recites a controller that uses multiple "register interfaces," each of which includes multiple registers. *Wu* contains absolutely no mention that the "register interfaces" are used to facilitate data transfers between registers. For example, *Wu* fails to recite that the "register interfaces" are used to transfer data from one register into another register. As a result, *Wu* fails to disclose, teach, or suggest a "plurality of register transfer units" that

“facilitate transfers of data” among “interface registers” as recited in Claim 1.

Second, the Applicants have repeatedly pointed out that the system of *Smyers* does not transfer data between registers and therefore does not need a data transfer mechanism. In particular, the Applicants have repeatedly shown that *Smyers* lacks any mention of communicating data between control registers (element 38), a first register set (element 24), and a second register set (element 28). The Office Actions have repeatedly failed to identify any portion of *Smyers* indicating that data is transferred between these registers in *Smyers*. Because the Office Action cannot show that *Smyers* transfers data between registers, the Office Action cannot show that a person skilled in the art would modify *Smyers* to transfer data between registers using a “plurality of register transfer units” as recited in Claim 1.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 1 (and its dependent claims). For similar reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 11 (and its dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejections and full allowance of Claims 1-5 and 11-16.

III. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.


The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

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